

U.S. Patent Application No. 09/620,484
Attorney's Docket No. 99-317RCE2

REMARKS

This amendment is responsive to the final Office Action¹ dated March 30, 2006 in this second request for continued examination in this application. In the instant Office Action, the Examiner does not continue to apply Barkan et al., U.S. Patent 6,366,575, but is alleging yet another new ground of rejection based on newly-cited U.S. Patent No. 6,130,933 to Miloslavsky et al.

Claims 1-2, 4-5, 7-8, 10-11, 13-20, 25 and 27-37 were presented for continued-examination and continue to be rejected. The independent claims are claims 1, 7, 13, 14, 17, 20, 25, 27, and 30.

More specifically claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, and 27-37 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Patent Number 6,275,490 to MATTAWAY et al. (hereinafter "MATTAWAY") in view of newly-cited Patent Number 6,130,933 to MILOSLAVSKY et al. (hereinafter "MILO"). Claims 14-20 are rejected under 35 U.S.C § 103(a) as being un-patentable over MATTAWAY in view of MILO in further view of WIENER et al., U.S. Patent Number 6,324,264 (hereinafter WIENER). Applicant respectfully traverses the rejection of these claims for the following reasons.

¹ The final Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicant deems allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicant that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

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Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, and 27-37 are rejected under 35 U.S.C. § 103(a) as being un-patentable over MATTAWAY in view of MILO. Applicant's claim 1, for example, recites, *inter alia*:

signaling, via a packet-switched network, a telecommunication system to connect a call between the selected telephone number and the calling party telephone number using the retrieved data by ringing a telephone associated with the calling party telephone number before calling the selected telephone number and, if the telephone is not answered within a specified period of time, by sending a message to the computer to request that the calling party re-enter the calling party telephone number thereby obtaining a locally stored and re-entered calling party telephone number superceding the calling party telephone number and by calling the re-entered calling party number before calling the selected telephone number; (Claim 1, Emphasis added)

The final Office Action, page 5 admits that:

"Mattaway in view of Miloslavsky does not expressly disclose that if the telephone is not answered within a specified period of time, sending a message to the computer to request that the calling party re-enter the calling party telephone number thereby obtaining a locally stored and re-entered calling party telephone number superceding the calling party telephone number and calling the re-entered calling party number before calling the selected telephone number; and using the locally stored and re-entered calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number if the locally stored calling party telephone number is superceded." (O.A. page 5, top, emphasis added)

In order to deal with this admitted deficiency in the MATTAWAY-MILO combination, the final Office Action takes a flawed position which Applicant shall address below.

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Immediately following the above-quoted passage, the next Office Action sentence is:

"However, Miloslavsky discloses checking to see if the telephone is answered within a specified period of time (the line is busy) (col. 3, lines 20-23)." And, this particular passage states:

"After the telephone number corresponding to the telephone in the first site is dialed and upon determining it is able to receive the phone call (i.e., the line is not busy), an agent who is able to handle the phone call is selected." (MILO, col. 3, lines 20-23)

Apparently the Examiner is attempting to map the language "the line is not busy" in this passage to Applicant's "if the telephone is not answered within a specified period of time" as recited in claim 1 (emphasis added). However this language does not specify a period of time for the busy signal. The length of time of a busy signal is variable and, without a time constraint imposed on that signal (and there is no such constraint disclosed or suggested in MILO) it is necessarily transmitted for a non-specified period of time.² Therefore, the position taken in the final Office Action that a specified period of time is equivalent to a line that is busy is a flawed position, and this section in MILO is ineffective to disclose or suggest this "specified period of time" limitation in the signaling step in Applicant's claim 1. Accordingly the 35 U.S.C. §103(a) rejection of claim 1 should be withdrawn and the claim allowed on this basis alone.

Furthermore, Applicant's claim 1 recites, interalia, "...ringing a telephone associated with the calling party telephone number before calling the selected telephone number, and if the telephone is not answered within a specified period of time..." (emphasis added). Applicant submits that a busy signal, upon which the final Office Action is (erroneously) relying to show a

² Even if a busy signal would eventually stop, giving way to silence, that follow-on silence would be ongoing without limitation wherefore a fixed period busy signal with its variable and unlimited follow-on silence would not read on: "if the telephone is not answered within a specified period of time." That telephone would remain unanswered indefinitely.

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specified period of time, is certainly not an indication of a telephone that is "ringing" for any time period, specified or otherwise. To the contrary, a busy signal is generated by a telephone that is pre-occupied with a previously placed, or previously received, call and cannot "ring." Indeed, by seizing upon what is apparently the only event in MILO, i.e., a busy signal, that might colorably or allegedly relate to Applicant's claimed "if the telephone is not answered within a specified period of time" the Office Action has chosen a condition under which that telephone is unable to "ring" (not to mention the fact that the busy-signal telephone is the called party telephone, to be discussed below). Therefore, this section in MILO (or any other section of MILO) is ineffective to disclose or suggest this "ringing" limitation in Applicant's signaling step in Applicant's claim 1 for these reasons. Accordingly the 35 U.S.C. §103(a) rejection of claim 1 should be withdrawn and the claim allowed on this additional basis alone.

Immediately following the above-quoted sentence in the final Office Action, the next sentence states: "Milosklavsky also discloses signaling a party to enter the calling party telephone number and storing this number to connect subsequent calls (col. 3, lines 20-23 and col. 9, lines 3-16)." (Emphasis added.) Therefore, in addition to the same col. 3, lines 20-23 passage quoted above relating to MILO's busy signal, to support this sentence the final Office Action also relies on the col. 9, lines 3-16 portion of the following section:

Another embodiment of the present invention is now described. In this embodiment, call center 102 initiates the telephone call (in response to a request by a user in customer site 104) instead of customer site 104 initiates [initiating] the telephone call. Referring now to FIG. 1, the user requests a telephone call by clicking on button 118 (which could be labeled a "call me" button). A dialog box appears. It asked [asks] the user to enter the telephone number of phone 128. Browser 116 then sends the telephone number of phone 128 to server 132 in provider site 102. Alternatively, the telephone number could have been previously stored in computer 114 (e.g., in the form of a persistent client state information commonly called the "cookies" in Internet technical

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literature). Server 132 then sends the telephone number and associated data (e.g., the identity of customer site 104 and the HTML document associated with the web page displayed on browser 116) to SRP 168. SRP 168 then requests service assistance center 140 to call this telephone number and select an agent to talk with the user. (col. 8, line 66 through col. 9, line 16; Emphasis added.)

The above-quoted section says: "call center 102 initiates the telephone call" and the "user requests a telephone call" and that button 118 (the user's GUI icon) could be labeled a "call me" button. Therefore, it is clear from this passage that user telephone 128 is not the telephone of the calling party, but is the telephone of the called party, at least in this "Another embodiment." Thus, this section does not support the statement in the Office Action: "Milosklavsky also discloses signaling a party to enter the calling party telephone number and storing this number to connect subsequent calls (col. 3, lines 20-23 and col. 9, lines 3-16)." (Emphasis added.) For these reasons, the position taken in the Office Action is flawed and this section in MILO is ineffective to disclose or suggest this limitation in the signaling step of Applicant's claim 1. Accordingly the 35 U.S.C. §103(a) rejection of claim 1 should be withdrawn and the claim allowed on this additional basis alone.

Note that this section of MILO starts with: "Another embodiment of the present invention..." This alternative embodiment in MILO is the embodiment in which call center 102 places a call to user telephone 128, and is the only embodiment in MILO in which there could possibly be a busy signal. User telephone 128 could be busy. Since the Office Action relies upon the busy signal comment in MILO as apparently the only activity disclosed in MILO to allegedly be comparable with Applicant's recited "specified time", and since the busy signal in MILO appears only in connection with its alternative embodiment, then the final Office Action is constrained to apply only the alternative embodiment in MILO against Applicant's claims.

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There is no busy signal disclosed in MILO as being associated with MILO's primary embodiment, nor can there be, because in the primary embodiment the call is placed by telephone 128 to call center 102 where calls, typically, are automatically routed to human or computer-synthesized voices, or possibly put on hold with silence or music for an unspecified time until a human agent is available - and none of this activity amounts to a busy signal. Moreover, no busy signal is disclosed in MILO with respect to the primary embodiment. Since the final Office Action relies upon a busy signal in MILO to support its (flawed) position on "a specified period of time", and since the only busy signal in MILO is associated with telephone 128 in a called party capacity, then this set of constraints prevents the final Office Action from properly mapping MILO to several of the elements of Applicant's claim 1, not to mention the inherent unspecified time period deficiency of the busy signal noted above.

Indeed, referring to the final Office Action, page 3, bottom to page 4, top, where the Examiner alleges that MILO teaches Applicant's "determining" step, "prompting" step, "signaling step" and "using step", none of these steps are disclosed or suggested in MILO because in each claim element the calling party telephone is recited where MILO's alternative embodiment discloses or suggests the called party telephone in each case, as follows:

- In the alternative embodiment of MILO with regard to Applicant's recited "determining" MILO may determine if a called party telephone number (the telephone number for telephone 128) was previously stored in its service assistance center 140. This does not read on Applicant's determining step.
- In the alternative embodiment of MILO with regard to Applicant's recited "prompting", MILO may prompt a user to enter its telephone number in the icon 118, but that is the

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called party's telephone number, not the calling party's telephone number. This does not read on Applicant's recited prompting step.

- In the alternative embodiment of MILO with regard to Applicant's recited "signaling", MILO does not read on Applicant's recited signaling step for any or all of the reasons detailed above.
- Finally, in the alternative embodiment of MILO with regard to Applicant's "using" step, , if any telephone number is stored at the call center, it is user's telephone number which is the called party's number that is stored in the call center. This does not read on Applicant's recited using step which uses the "stored calling party telephone number" or the "stored and re-entered calling party telephone number".

Therefore, as pointed out above, MILO does not disclose or suggest at least these four elements of Applicant's claim 1.

It is further submitted that WIENER, cited merely to show subject matter related to packet-switched calls and circuit switched calls, does not cure these deficiencies of the MATTAWAY and MILO combination.

In accordance with MPEP 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make

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the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. And, all three of these basic criteria must be met - if any one is not met the prima facie case of obviousness is not made. In this instance, the prior art references, MATTAWAY, MILO and/or WIENER when combined do not teach or suggest all of the limitations of claim 1, for reasons given above. Thus, the other two criteria are mooted and need not be discussed at this time. Accordingly, the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn and the claim allowed.

The other independent claims, namely claims 7, 13, 14, 17, 20, 25, 27 and 30 each contain all of the same, or similar, limitations that were discussed above, and each is allowable for reasons that are the same as, or similar to, those given above with respect to claim 1.

All dependent claims depend ultimately from one of the allowable independent claims and, therefore, partake in the allowability of their respective allowable base claim. All dependent claims are allowable for at least that reason. Accordingly, the 35 U.S.C. § 103(a) rejection of claims 2-5, dependent from allowable base claim 1, claims 8-11, dependent from allowable base claim 7, claims 15-16, dependent from allowable base claim 14, claims 18-19, dependent from allowable base claim 17, claims 28-29, dependent from allowable base claim 27 and claims 31-37, dependent from allowable base claim 30 should be withdrawn and the claims allowed.

Applicant does not acquiesce in any of the rejections made in reliance upon MILO in combination with any of the other applied references, and expressly reserves its rights to present additional arguments without limitation in rebuttal thereto.

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CONCLUSION

In view of the foregoing remarks, all pending claims are urged to be allowable over the cited references. Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

If any questions remain, the Examiner is invited to contact the undersigned at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being transmitted by facsimile to the United States Patent Office at 571-273-8300.

Dated: May 30, 2006

 (Christian R. Andersen)